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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,187	09/24/2003	Gregory R. Gale	PFB.P.1100	2613

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EXAMINER

TAWFIK, SAMEH

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/669,187	<b>Applicant(s)</b> GALE, GREGORY R.	
	<b>Examiner</b> Sameh H. Tawfik	<b>Art Unit</b> 3721	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12162003</u> . | 6) <input type="checkbox"/> Other: ____.   |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said driven rollers" in line 22. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Gosslinghoff (5,542,349).

Cosslinghoff discloses a device for returning folded paper at near or around a paper input end comprising: a frame comprising opposing side plates (Fig. 5; via frame 35); a first conveyer system including a first endless conveyer belt (Fig. 1; via 17 and 19), a first driven roller (Fig. 1; via 21), and at least one freely rotatable guide roller (Fig. 1; via 3), wherein said first conveyer belt (17) is wrapped around said first driven roller (21) and said at least one freely rotatable guide roller (3), wherein said first driven roller (21) is rotatable in a counter-clockwise direction

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thereby driving said first endless conveyer belt (17) in a first direction (fig. 1), and said at least one freely rotatable guide roller (3) guides and supports said first conveyer belt; and a second conveyer system including a second endless conveyer belt (18 and 20), and at least two freely rotatable guide rollers (4 and 6), wherein said second conveyer belt (18) is wrapped around said at least two freely rotatable guide rollers (4 and 6), said at least two freely rotatable guide rollers rotate in a direction opposite to said first driven roller (Fig. 1), and said second conveyer system is located underneath said first conveyer system (Fig. 1); wherein said guide rollers extend between said opposing side plates of said frame, and wherein "said driven rollers" are adapted to be mounted to the existing frame of a paper folding machine along (Fig. 5); note that it is inherent Gosslinghoff's pressing station which also considered as feeding/returning station is located downstream of folding station as shown in Fig. 1 feeding folded newspaper 33 which were folded prior to the pressing step.

Regarding claim 2: wherein said a second conveyer system includes a second endless conveyer belt (20), a second driven roller (24), and at least two freely rotatable guide rollers (4 and 6), wherein said second conveyer belt (20) is wrapped around said second driven roller (24) and said at least two freely rotatable guide rollers (4 and 6), said at least two freely rotatable guide rollers rotate in a direction opposite to said first driven 30 roller (Fig. 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosslinghoff (5,542,349).

Cosslinghoff does not disclose that the first conveyer system includes three endless conveyer belts nor the second conveyer system includes three endless conveyer belts. However, Cosslinghoff discloses that the first conveyer system includes two endless conveyer belts (Fig. 1; via 17 and 19) and the second conveyer system includes two endless conveyer belts (Fig. 1; via 18 and 20). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Cosslinghoff's first and second conveyer system with a third endless belt, in order to have stronger support to the folded articles and it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 6: Gosslinghoff discloses a frame (Fig. 5; via frame 35); a sheet feeder supported by the frame (Figs. 1 and 5; via feed conveyor 34) for delivering sheets of paper (fig. 3) to a sheet folding mechanism; note that it is inherent Gosslinghoff's pressing station which also considered as returning station is located downstream of folding station as shown in Fig. 1 feeding folded newspaper 33 which were folded by folding station prior to the pressing step and also feeding station to feed the sheet to the folding station is obvious; means for driving the device for returning folded paper (Via. driven rolls 21, 22, 23, and 24). Gosslinghoff does not disclose that the device for returning folded paper disposed underneath the sheet feeder and folding mechanism. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Gosslinghoff apparatus by having the device for returning folded paper disposed underneath the sheet feeder and folding mechanism,

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in order to make the apparatus shorter and save more space on the manufacturing line, and it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Regarding claim 7: Gosslinghoff discloses that wherein said a second conveyer system includes a second endless conveyer belt (20), a second driven roller (24), and at least two freely rotatable guide rollers (4 and 6), wherein said second conveyer belt (20) is wrapped around said second driven roller (24) and said at least two freely rotatable guide rollers (4 and 6), said at least two freely rotatable guide rollers rotate in a direction opposite to said first driven 30 roller (Fig. 1).

Regarding claim 11: Gosslinghoff discloses means for driving the device for returning folded paper (Via. driven rolls 21, 22, 23, and 24), note that it is inherent it would be a motor in Gosslinghoff's apparatus to generate rotation of the driven rolls.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brotherston 6378865, Moser 5775689, Levaro 5465825, Boriani 5358234, Suter 5342038, Svyatsky 5150891, Fischer 4269402, Hantscho 3206191, and Colwill Re. 29178 disclose different folding and returning apparatus.

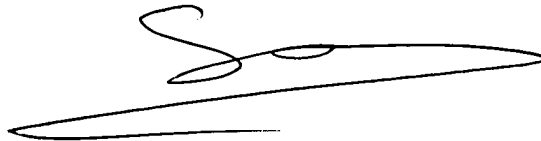
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is (703) 308-2809. The examiner can normally be reached on Tuesday - Friday from 8:00 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sameh H. Tawfik  
Patent Examiner  
Art Unit 3721

A handwritten signature in black ink, appearing to be 'Sameh H. Tawfik', written over a horizontal line.

ST.